

### **Remarks**

Claims 1 and 5-12 are pending in the above-identified patent application. Claims 11-12 are withdrawn from consideration. With this Response, new claims 17-23 are added. Upon entry of the current amendment, claims 1, 5-12, and 17-23 are pending.

Applicant submits that new claims 17-23 are fully supported by the application as originally filed (discussed below) and do not present new matter.

Reconsideration and further examination of the application are respectfully requested in view of the amendment above and remarks below.

### **Telephonic Interview**

Applicant gratefully acknowledges the telephonic interview granted by Examiner Fidei between the Examiner and Applicant's undersigned representative, Paul John Parins, on July 14, 2006.

Independent claim 1 was discussed, but agreement was not reached. The Examiner suggested submitting method-type claims for consideration.

Accordingly, as discussed below, new method claims 17-23 are submitted herewith.

In the event that a phone conference between the Examiner and the Applicant's undersigned attorney would help resolve any remaining issues in the application, the Examiner is invited to contact the undersigned.

### **Added New Claims 17-23**

New claims 17-23 are method claims directed to a method of sealing a container for storing items. Independent claim 17, from which claims 18-22 depend, features a method of using shrinkwrap to seal a container having a tapered sidewall such that the shrinkwrap can be separated from the container lid to gain access to the container, yet the shrinkwrap is held in place against the tapered sidewall when the container lid is removed. The method of claim 17 can achieve such a useful result by combining a particular container with a tubular layer of shrinkwrap in a unique manner. The container includes an annular surface discontinuity between the rim and bottom of the container and has a shape such that when the shrinkwrap forms to, covers, and conforms to the

shape of the surface discontinuity, the surface discontinuity helps hold the shrinkwrap in place against the sidewall when the container lid is removed.

Advantageously, claim 17 also features that a non-adhesive label is trapped between the shrinkwrap and sidewall while the lid is removed.

Applicant notes that many prior art containers having a tapered sidewall would require an adhesive to help retain the shrinkwrap to the tapered sidewall while the container lid is removed. According to the present invention, using an adhesive in such a manner is not necessary.

Support for claim 17 can be found in the specification at, e.g., page 2, lines 25-28 and page 9, line 18 to page 10, line 5. Support for dependent claims 18-23 can be found in the specification at, e.g., as follows: claim 18 (page 10, lines 4 and 5); claim 19 (page 6, lines 8-11); claim 20 (page 6, lines 13-15); claim 21 (page 6, lines 3-5); claim 22 (page 6, lines 6-8); and claim 23 (page 8, lines 3-5).

It is believed that no fee(s) are required for adding claims 17-23 because of claims previously paid for and subsequently cancelled. However, if any other fee(s) are required for adding claims 17-23, please charge all of the appropriate fee(s) to the Kagan Binder Deposit Account No. 50-1775 and notify us of the same.

### **Claim Rejections – 35 U.S.C. § 112**

Claims 1 and 5 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

According to the Office Action, claims 1 and 5 are indefinite because base claim 1 features a non-adhesive label and dependent claim 5 features a label that is adhesively fixed to the outside of the shrinkwrap.

This rejection is respectively traversed because the scopes of claims 1 and 5 are clear in view of the respective claim language and moreover in view of the specification.

Claim 1 recites:

... a non-adhesive label trapped between the shrinkwrap and the side wall, said label remaining trapped after the lid is removed.

And claim 5 recites:

The container of claim 1, further comprising a label adhesively affixed to the outside of said shrinkwrap layer about said side wall. (Underlining added for emphasis).

That is, claim 5 features a label adhesively affixed to the outside of the shrinkwrap in addition to the non-adhesive label featured in base claim 1.

Moreover, Applicant's specification also describes the concept of being able to have a label adhesively affixed to the outside of the shrinkwrap in addition to a non-adhesive label trapped between the shrinkwrap and the side wall (see the specification at, e.g., page 3, line 22 to page 4, line 4).

Accordingly, it is respectfully submitted that claims 1 and 5 are definite and comply with the requirements under 35 U.S.C. §112, second paragraph. It is respectfully requested that the rejection of claims 1 and 5 under 35 U.S.C. §112, second paragraph, as being indefinite, be withdrawn.

### **Claim Rejections – 35 U.S.C. §103**

Claims 1 and 5-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Muraoka (U.S. Pat. No. 4,018,904) in view of Gray, Jr. (U.S. Pat. No. 5,489,126).

Applicant respectfully traverses this rejection because the Muraoka and Gray, Jr. references, alone or in combination, do not teach, motivate, or suggest the surface discontinuity/shrinkwrap combination feature of claim 1.

Claim 1 features a container having a unique combination of a particular surface discontinuity with a shrinkwrap layer. The surface discontinuity is an annular surface discontinuity disposed on the tapered side wall of the container between the rim and bottom of the container. A tubular layer of shrinkwrap envelops the tapered side wall and an outer periphery of the container lid to help secure the lid to the side wall. The shrinkwrap is also separable from the lid and rim to allow the lid to be removed while said layer of shrinkwrap is formed to, covers, and conforms to the shape of the surface discontinuity to advantageously help hold the enveloping shrinkwrap in place on the sidewall when the lid is removed. As yet another advantage, claim 1 also features a non-adhesive label trapped between the shrinkwrap and the side wall even after the lid is removed.

Muraoka discloses an instant food container 1 having a covering 4 (see Muraoka at col. 2, lines 26-30). Container 1 has an outer receptacle 2 that includes two cylindrical portions 6 and 7, joined by tapered portion 8, and a truncated cone portion joined to

cylindrical portion 7 by tapered portion 10 (see Muraoka at col. 2, lines 26-48 and Fig. 1). Container 1 is covered by a heat-shrinkable sheet of film 5 to help protect the instant food in the container against possible contamination (see Muraoka at col. 1, lines 18-20 and col. 2, lines 30-33). According to Muraoka, at the time of use, the wrap of film 5 is “removed away from the container” to remove covering 4 and gain access to the instant food (see Muraoka at col. 3, lines 44-46).

The Muraoka reference fails to teach a surface discontinuity that helps hold the shrinkwrap in place on a sidewall of a container when the lid is removed. According to the Office Action, tapered portion 10 is such a surface discontinuity. However, it is respectfully submitted that tapered portion 10 would not help hold a shrinkwrap layer 5 in place against the sidewall of container 1 if shrinkwrap 5 was removed away from the top portion of container 1 to remove covering 4. Tapered portion 10 could not hold shrinkwrap 5 up in such a manner because tapered portion 10 progressively narrows downward. That is, if shrinkwrap 5 were removed from only the top portion of container 1, the shrinkwrap 5 surrounding the side of the container would fall from the side of the container.

Moreover, the Muraoka reference does not necessarily teach that shrinkwrap 5 forms to and conforms to the shape of tapered portion 10. For example, there appear to be gaps of space between 1) at least portions of the cylindrical portions 6 and 7 and tapered portion 8, and 2) shrinkwrap 5 (see Muraoka at Fig. 1). And in viewing Figure 1 with respect to tapered portion 10, it is not unambiguously clear whether the shrinkwrap 5 forms to and conforms to the shape of tapered portion 10 or if there is a gap of space between the tapered portion 10 and shrinkwrap 5. The text of the Muraoka reference does not clarify this.

The Muraoka reference fails to motivate or suggest a surface discontinuity that helps hold shrinkwrap in place on a sidewall of a container when the lid is removed. As mentioned above, Muraoka discloses that the shrinkwrap 5 helps protect the instant food from contamination and at the time of use, the wrap of film 5 is merely “removed away from the container” to remove covering 4 and gain access to the instant food (see Muraoka at col. 1, lines 18-20; col. 3, lines 44-46; and col. 4, line 18). Muraoka does not disclose any reason to keep the shrinkwrap 5 in place against the sidewall of container 4 when covering 4 is removed.

The Gray, Jr. reference fails to cure the deficiencies of Muraoka because the Gray reference does not teach, motivate, or suggest to provide the Muraoka container with a surface discontinuity that helps hold shrinkwrap in place on the sidewall of the Muraoka container when the covering 4 is removed.

The Gray, Jr. reference relates to particular pipe fittings having a label secured thereto with a substantially transparent plastic tube which is shrunk with heat around the pipe fitting and the label. (See, Gray, Jr. at the Abstract). For example, Figures 1 and 2 of the Gray, Jr. reference show cylindrical pipe fittings. The Gray, Jr. reference does not even remotely relate to a container having a side wall tapering from top to bottom or a surface discontinuity that can help hold shrinkwrap in place on the sidewall when the lid is removed. Indeed, the Office Action relied on the Gray, Jr. reference merely for disclosing the use of adhesive-free labels.

Accordingly, it is respectfully requested that the rejection of claims 1 and 5-7 under 35 U.S.C. §103(a) as being unpatentable over Muraoka in view of Gray, Jr. be withdrawn.

Claims 1 and 5-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ando (U.S. Pat. No. 3,976,795) in view of Karevaara (U.S. Pat. No. 4,102,454) and Gray, Jr. (U.S. Pat. No. 5,489,126) or Kaufman (U.S. Pat. No. 6,247,612).

Applicant respectfully traverses this rejection because the Ando; Karevaara; Gray, Jr.; and Kaufman references, alone or in combination, do not teach, motivate, or suggest an annular surface discontinuity disposed on a tapered side wall of a container in combination with a tubular layer of shrinkwrap that forms to, covers, and conforms to the shape of the surface discontinuity to help hold the shrinkwrap in place on the sidewall when the container lid is removed.

The Ando reference fails to teach, motivate, or suggest the surface discontinuity/shrinkwrap combination feature of claim 1. According to page 4 of the Appeal Decision mailed November 18, 2005, the Ando reference does not even disclose a surface discontinuity disposed between the bottom and rim of the container. And the Ando reference indicates that at the time of use, the shrinkwrap is merely ripped open to take off the container cover (see Ando at col. 3, lines 19-29) so there is no indication in

the Ando reference that there is a desire or need to retain the shrinkwrap against the sidewall of the container if the film has been torn away from the top of the container.

Modifying the Ando container with the Karevaara mug fails to cure the surface/shrinkwrap combination deficiency of the Ando reference. That is, Karevaara does not teach, motivate, or suggest that an enveloping layer of shrinkwrap would form to and conform to the shape of the annular projections 5 and 6 to help hold the enveloping shrinkwrap in place on the sidewall when the cover is removed. The Karevaara reference does not even mention that the Karevaara mug is shrinkwrapped. If the Karevaara mug was shrinkwrapped it could have gaps of space between the shrinkwrap and side wall near the projections 5 and 6 in a manner similar to Fig. 1 of the Muraoka reference discussed above instead of having the shrinkwrap form to and conform to the shape of the annular projections 5 and 6 to help hold the enveloping shrinkwrap in place on the sidewall when the cover is removed.

Indeed, it would be contrary to the teachings of Karevaara to retain the shrinkwrap to the side wall of the Karevaara mug when the lid is removed because the handles of the Karevaara mug would need to be deployed at the time of taking the cover off so any shrinkwrap on the side of the Karevaara mug would need to be removed.

Paragraph 6 on page 4 of the Office Action indicates that page 6 of the Appeal Decision mailed November 18, 2005 addressed the surface discontinuity/shrinkwrap combination feature of presently pending claim 1. Applicant strongly disagrees that such Appeal Decision addressed an annular surface discontinuity disposed on a tapered side wall of a container in combination with a tubular layer of shrinkwrap that forms to, covers, and conforms to the shape of the surface discontinuity to help hold the shrinkwrap in place on the sidewall when the container lid is removed. Claim 1 was amended after the Appeal Decision to recite, *inter alia*, “to help hold the enveloping shrinkwrap in place on the sidewall when the lid is removed” and the Board did not address such functional language between the surface discontinuity/shrinkwrap combination.

Neither Gray, Jr. nor Kaufman cure the deficiencies of Ando/Karevaara in that neither the Gray, Jr. nor Kaufman can overcome the negative bias of Karevaara to remove the shrinkwrap from a container sidewall to deploy the Karevaara handles.

Accordingly, it is respectfully requested that the rejection of claims 1 and 5-10 under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Karevaara and Gray, Jr. or Kaufman be withdrawn.

**Conclusion**

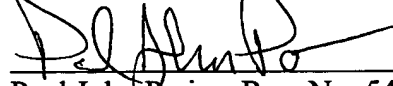
In view of the above remarks, it is respectfully submitted that the claims and the present application are now in condition for allowance, which allowance is earnestly solicited. In the event that a phone conference between the Examiner and the Applicant's undersigned attorney would help resolve any remaining issues in the application, the Examiner is invited to contact the undersigned as set out below.

Dated:

July 17, 2006

By:

Respectfully Submitted,



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